

BESSETTE et al.  
Appl. No. 09/604,082

Atty. Docket No. 4380-107

### REMARKS/ARGUMENTS

Claims 4, 19 and 25 are pending. Claims 5-18, 20-44 and 46-49 have been canceled without prejudice or disclaimer of the subject matter they contain. In an effort to advance prosecution, claims 4, 19 and 25 are amended to encompass infringing subject matter. No new matter has been added. By the amendments, Applicant does not acquiesce to the propriety of any of the Examiner's rejections and does not disclaim any subject matter to which Applicant is entitled. *Cf. Warner Jenkinson Co. v. Hilton-Davis Chem. Co.*, 41 U.S.P.Q.2d 1865 (U.S. 1997). Further, Applicant reserves the right to file continuing applications to cover disclosed subject matter not encompassed by the currently pending claims.

Applicant is grateful for the courtesies extended to the Applicant and the undersigned representative during the personal interview conducted on October 19, 2005. A separate record of the substance of the personal interview is incorporated in the paragraphs below.

### REJECTION UNDER 35 U.S.C. § 112

The Office Action rejects claims 4 and 19 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement allegedly because the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the Office Action asserts that the phrase "pesticidally active ingredient consisting of rosemary oil and phenethyl propionate" in claim 4 and the phrase "pesticidally active ingredient consisting of rosemary oil, peppermint oil and phenethyl propionate" in claim 19 have no support in the as-filed specification and thus constitutes "new matter". The Office Action further alleges that these

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phrases neither have literal support in the as-filed specification by way of generic disclosure nor are there specific examples of the newly limited genus that would show possession of the concept of the use of "pesticidally active ingredient" that is limited to 2 or 3 components as in the method of claim 4 or in the method of claim 19 respectively. Applicant respectfully traverses this rejection.

The fundamental issue in new matter rejections is whether the alleged objectionable material was inherently contained in the original application. See *Litton Sys., Inc. v. Whirlpool Corp.*, 221 U.S.P.Q. 97 (Fed. Cir. 1984). In a sense, anything inserted in a patent application that was not there before is "new" to the specification, but that does not necessarily mean that it is prohibited as "new matter." *In re Oda*, 170 U.S.P.Q. 268, 271 (C.C.P.A. 1971) (quoting Robinson On Patents (1890), § 561). Of course, if the objected to changes are radical in nature and constitute a departure from the invention originally disclosed, then they are not permissible. *In re Oda*, 170 U.S.P.Q. at 271. However, amendments concerned with an inherent characteristic of claimed subject matter sufficiently described in the originally-filed disclosure is not prohibited by statute. *Ex parte Davisson and Finlay*, 133 U.S.P.Q. 400, 402 (1958). In the present patent application, Applicants respectfully submit that the objected to phrases do not constitute new matter.

Here, Applicants respectfully submit that the knowledge and level of skill in the art would permit one skilled in the art to immediately envisage the composition recited in the claims from the as-filed specification from at least page 3, line 25 to page 4, line 11, which describes that the pesticidal composition of the present comprises rosemary oil, in admixture with a suitable carrier...and optionally with *one or more natural or synthetic plant essential oil compounds*. Applicant respectfully submits that the objected to claims merely recite a

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pesticidal composition that is a more concise recitation of the subject matter generically described in the written description. It is believed that the objected to phrases further clarify the claimed subject and maintains consistency with the terms throughout the written description and originally filed claims, as well as the exemplified plant essential oil compounds, of which peppermint oil is described as one such example. The objected to phrases are not radical in nature and do not constitute a departure from the invention originally disclosed. In other words, the disclosure as originally filed reasonably conveys to the artisan that Applicant had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support. *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 227 U.S.P.Q. 177 (Fed. Cir. 1985).

Applicants respectfully submit that the objected to phrases merely recite what is an inherent characteristic of the present invention and is sufficiently described in, and supported by, the originally-filed disclosure. One of skill in the art reading the previously amended claims could readily believe that the Applicant had possession of the claimed subject matter because it is inherently disclosed, although possibly differently described. Thus, Reconsideration and withdrawal of this rejection are respectfully requested.

**REJECTION UNDER 35 U.S.C. § 102(b)**

The Office Action rejects claim 45 under 35 U.S.C. § 102(b) as being anticipated by JP 07145598. The Office Action states that JP 07145598 discloses a method for controlling mold and mites comprising step of applying to a location (e.g., a pocket or in a chamber (translation par. 0016)) a pesticidal composition comprising 1) a pesticidally active ingredient consisting of rosemary oil and peppermint oil and 2) a carrier in a form of additional plant oils. The Office

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Action acknowledges that JP 07145598 teaches that the disclosed composition has disinfecting properties. Applicants respectfully traverse this rejection.

As discussed during the personal interview, JP 07145598 does not teach or suggest killing household pests by contacting them with a pesticidally-effective amount of a composition comprising a pesticidally acceptable carrier and a pesticidally active ingredient consisting of rosemary oil and peppermint oil, as presently claimed. JP 07145598 merely teaches disinfecting a location where a disinfecting effect is desired. Thus, reconsideration and withdrawal of this rejection are respectfully requested.

**REJECTION UNDER 35 U.S.C. § 103(a)**

The Office Action rejects 4, 19 and 45 under 35 U.S.C. § 103(a) as being unpatentable over JP 07145598 taken with Granirer et al. (U.S. 4,759,930) and McGovern et al. (U.S. 3,761,584). The Office Action states that JP 07145598 is relied upon as explained above for the disclosure of a method for controlling household pests including molds and mites wherein the method comprises a step of applying to a location where control is desired a composition comprising rosemary oil, peppermint oil *and other plant oils*. Granirer is apparently cited as disclosing the incorporation of *boric acid* (known insecticide for extermination of cockroaches) and the use plant leaves (not oils) including *leaves of rosemary and peppermint* in a method for killing insects. Because neither JP 07145598 nor Granirer teach or suggest the use of phenethyl propionate, the Office Action apparently relies on U.S. Patent No. 3,761,584 as disclosing the use of *phenethyl propionate for attracting pests or insects* to a location where pest or insect control is desired. Applicants respectfully traverse this rejection.

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Applicant respectfully submits that the rejected claims each patentably distinguish over the cited references, alone or improperly combined. The deficiencies of JP 07145598 are discussed above. Neither Granirer nor U.S. Patent No. 3,761,584 remedy those deficiencies. As discussed during the personal interview, it would not have been obvious to one having ordinary skill in the art at the time the claimed invention was made to add phenethyl propionate to the compositions disclosed in JP 07145598 or Granirer nor to arrive at a method for killing household pests comprising contacting them with the specific compositions recited in the currently pending claims. Indeed, no attraction step is needed in the presently claimed methods. Thus, reconsideration and withdrawal of this rejection are respectfully requested.

#### **DOUBLE PATENTING**

The Office Action rejects claim 19 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,531,163 in view of U.S. Patent No. 4,759,930 as explained in the prior Office Action.

In response, Applicant respectfully submits that U.S. Patent No. 6,531,163 does not teach the use of rosemary oil and the deficiencies of the '930 patent teachings are, as previously noted. Applicants respectfully submit that alone or improperly combined, the claimed invention, *as amended*, would not have been obvious over U.S. Patent No. 6,531,163 in view of the '930 patent. Reconsideration and withdrawal of this rejection are respectfully requested. However, if it is determined that claim 19 as ultimately allowed is unpatentable over the above-cited '163 patent under the judicially created doctrine of obviousness-type double patenting, then Applicants will consider submitting an appropriate Terminal Disclaimer.

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**CONCLUSION**

If anything further could be done to place the above-captioned patent application in better condition for allowance (i.e., via Examiner's Amendment), then please contact the undersigned attorney at the telephone number listed below.

Please grant any extension(s) of time deemed necessary for entry of this communication. The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper filed hereafter) to Deposit Account No. 14-1140.

Respectfully submitted,

NIXON &amp; VANDERHYE P.C.

Date: February 21, 2006By: Willem F. Gadiano  
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**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this document (including any paper referred to as being attached or enclosed) is being sent to the U.S. Patent and Trademark Office via facsimile transmission to (571) 273-8300 on the date indicated below, with a coversheet addressed to Commissioner for Patents, U.S. Patent and Trademark Office.

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